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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,259	12/21/2005	Jackie Papkoff	DEX0491US.NP	9408

32800 7590 03/25/2008
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EXAMINER

NATARAJAN, MEERA

ART UNIT	PAPER NUMBER
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1643

NOTIFICATION DATE	DELIVERY MODE
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03/25/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

poreilly@licataandtyrrell.com

DETAILED ACTION

1. Applicant's amendments in the reply filed on 01/10/2008 is acknowledged and entered into the record.
2. Claims 1-3, 6, 8, 10, 16, 19, 20, 22, 23, 30, 31, 35, 37, 39, 47, 61-63, 72-81 are pending. Claims 30, 31, 35, 37, 39, 47, and 61-63 have been withdrawn as directed to non-elected inventions.
3. Claims 1-3, 6, 8, 10, 16, 19, 20, 22, 23, and 72-81 will be examined on the merits.

Claim Rejections Maintained - 35 USC § 102

4. The rejection of Claims 1, 3, 16 and 20 under 35 USC 102 as being anticipated by Antalis et al., Bandman et al., is maintained for the reasons of record. Applicant's argue Antalis et al. and Bandman et al. do not teach antibodies that have the characteristic of binding to Pro104 (also known as testisin) on a mammalian cell "in vivo". Applicant's arguments have been carefully considered but are not deemed persuasive to overcome the rejection of record.
5. Both Antalis et al. and Bandman et al. teach Pro104 antibodies (known as either testisin or have the same sequence). Antalis et al. discloses the potential use of testisin antibodies as a therapeutic target, suggesting in vivo use of the antibody. Bandman et al. disclose antibodies which specifically bind HUPM may be used for the diagnosis of disorders characterized by expression of HUPM (see column 33). Although Antalis et al. and Bandman et al. do not specifically state the antibodies would bind in vivo, this limitation of the claim is a characteristic of a Pro104 antibody and is an inherent

characteristic. Therefore, one of ordinary skill in the art would envisage any Pro104 antibody would maintain this characteristic. The burden is therefore shifted to the Applicant to prove that the antibodies taught by Antalis et al. and Bandman et al. would not bind *in vivo*. Therefore, the rejection of the claims under 35 USC 102(b) as being anticipated is maintained for the reasons of record.

Claim Rejections Maintained - 35 USC § 103

6. The rejection of Claims 1-3, 8, 10, 16, 20, 22 and new claims 72 and 73 under 35 USC 103(a) as being unpatentable over Bandman et al. in view of Queen et al. is maintained for the reasons of record. Applicant's argue Bandman et al. does not teach an antibody that binds to Pro104 on a mammalian cell in vivo and Queen et al. does not remedy this deficiency of Badman et al. Applicant's arguments have been carefully considered but are not deemed persuasive to overcome the rejection of record.

7. As stated above, Bandman et al. disclose antibodies which specifically bind HUPM (which has the same sequence as Pro104) may be used for the diagnosis of disorders characterized by expression of HUPM (see column 33). Although Bandman et al. does not specifically state the antibodies would bind in vivo, this limitation of the claim is a characteristic of a Pro104 antibody and is an inherent characteristic.

Therefore, one of ordinary skill in the art would envisage any Pro104 antibody would maintain this characteristic. The burden is therefore shifted to the Applicant to prove that the antibodies taught by Bandman et al. would not bind *in vivo*. Queen et al. provides support for the limitations of a humanized antibody conjugated to toxins or a

detectable label. Therefore, the rejection of the claims under 35 USC 103(a) as being unpatentable over Bandman et al. in view of Queen et al. is maintained for the reasons of record.

All other rejections are withdrawn in view of the applicant's amendments and arguments thereto as set forth in the reply filed 01/10/2008.

Conclusion

8. Claims 6, 19, and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Claims 74-81 are allowed.

10. Claims 1-3, 8, 10, 16, 20, 22, 72 and 73 are rejected.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MEERA NATARAJAN whose telephone number is (571)270-3058. The examiner can normally be reached on Monday-Thursday, 9:30AM-7:00PM, ALT. Friday. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms can be reached on 571-272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MN

/Larry R. Helms/
Supervisory Patent Examiner, Art Unit 1643